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contact said skin region, said radiation passing into said skin region through said surface

REMARKS

Since the Office Action was mailed to Mr. Paul Clark at Fish & Richardson, it is not clear that the Revocation and New Power of Attorney which was filed in this application on October 20, 1995 was received and entered. Further, since claims 1-24 are indicated as being pending in the Office Action, it does not appear that the Preliminary Amendment filed November 29, 1995 was entered, which Amendment, among other things, resulted in the cancellation of claims 2, 5, 6, 8, 17 and 20. The Preliminary Amendment also made some amendments to claims 1 and 18, the two independent claims remaining in the application, the amendments above to claim 18 being a further amendment to this claim.

In the Office Action, the Examiner kindly indicated claims 1-16 as being allowed. Since the amendments to claim 1 were primarily matters of form, and in particular to make the language of the claim more precise, and such amendments did not increase the scope of the claim, it is assumed that claim 1 and the claims dependent thereon are still allowable.

The Examiner's rejection of claim 17 has been mooted by the fact that this claim was canceled in the Preliminary Amendment.

The Examiner has rejected claim 18 and the claims dependent thereon, both under 35 U.S.C. §112 for failing to particularly point out and distinctly claim the subject matter being claimed and on art under 35 U.S.C. §102 and 35 U.S.C. §103. Considering these objections individually:

Claims Rejections - 35 U.S.C. §112

Claim 18 was rejected on the basis that "[T]he elements recited are not structurally connected and present a mere cataloging of elements". Specifying that the contact device received the radiation generated by the means for generating was intended to provide the requisite connection. However, claim 18 has been amended

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above to make clear that the radiation is received from the means for generating, thereby more explicitly setting forth the connection of the elements.

Claim 19 was objected to as not being "clear as to which structure is being claimed". It was suggested in the Office Action that proper Markush format be used. This objection was overcome in the Preliminary Amendment by significantly simplifying claim 19. As amended, it is clear that this claim is referring to the convex surface 62 of the contact device, which surface is in contact with the area being treated.

Claim Rejections Under 35 U.S.C. §102 and §103

Claims 18-23 have been rejected under 35 U.S.C. §102(b) as being anticipated by Hoskins, et al. In reviewing the Applicants' device and the Hoskins device, it is clear that these are substantially different apparatus which function in different ways to achieve different objectives. In particular, Hoskins is concerned with treating port wine stains by having optical radiation concentrated in a region below the skin surface where the discolored cells are concentrated without causing damage to the skin surface above the stain. This is accomplished by providing a plate applicator having a plurality of needles, which needles penetrate the skin of the patient when the applicator is properly positioned, and applying radiation through light pipes 6 (optical fibers) directly to the needles. Light entering the needles is directed out of the needles in a direction substantially perpendicular to the skin surface to form a region 18 illuminated by the optical radiation which is just below the skin surface. It is noted that in Hoskins, optical radiation is neither applied to nor through the transparent contact device 2.

By contrast, the Applicants are seeking to have light energy penetrate deep into the skin of the patient to the base of the hair follicle and below. For this purpose, the contact device is interposed between the laser and the skin surface of the patient and light is passed through the contact device and through the surface thereof in contact with the skin of the patient into the skin region being treated. Claim 18 has been amended to make clear that the light is delivered to the skin

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through the surface of the contact device in contact with the skin. Claim 18 therefore now sets forth the clear structural (and functional) difference between the Applicants' device and that of the Hoskins reference and therefore clearly distinguishes over this reference under 35 U.S.C. §102 or 35 U.S.C. §103.

Claim 19 also distinguishes over Hoskins in that Hoskins neither shows nor suggests a contact device having a convex surface in contact with the skin through which light passes. Claim 20 was canceled in the Preliminary Amendment. Similarly, the contact device 2 in Hoskins is not a lens as required by claim 21, nor does the material of the device 2 in Hoskins meet the requirements of claim 22, 23 or 24. Therefore, all of these claims distinguish over Hoskins under 35 U.S.C. §102. Further, since Hoskins does not shine light through the device 2, he has no reason to form this device of a material having a refractive index match with the skin region, and certainly neither teaches nor suggests that it would be advantageous to do so. These claims therefore also distinguish over the Hoskins reference. Further, all of claims 19 and 21-24 are dependent on their allowable claim 18 and, incorporating all of the limitations of this parent claim, are also allowable for the same reasons discussed above with respect to claim 18.

In view of the above arguments and amendments, it is believed that this application is now in condition for allowance and favorable action thereon is respectfully requested.

Respectfully submitted,



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Attorney's Docket No. M0907/7000(RJK)
Date: June 28, 1996

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